

Appl. No. 10/648,655
Amdt. dated December 8, 2005
Reply to Office action of August 16, 2005

REMARKS

Reconsideration of this application is respectfully requested in light of the above amendments and the following remarks. After the amendments detailed above, claims 1-5, 7-12 and 14-34 are pending in this application. In particular, claims 1, 9 and 15 have been amended, claims 6 and 13 have been canceled, and claims 2-5, 7, 8, 10-12, 14 and 16-18 have been maintained in their previous form. New claims 19-34 have been added.

Applicant asserts that the amended claims and the new claims are fully supported by the disclosure of the Application as filed, and as such, do not introduce new matter. From the figures and the operation of LEDs it would be apparent to one skilled in the art that a portion of the emitted light would be normal to the finger or thumb on which the device is attached. The status of all the pending claims is reflected in the above listing.

I. ABSTRACT

Applicant has amended the abstract as suggested by the Examiner, therefore, this objection should be withdrawn.

II. 35 U.S.C. § 112

Claims 5 and 12

The Examiner has rejected claims 5 and 12 under 35 U.S.C. § 112 as being indefinite for not clearly depending from independent claims 1 and 9, respectively. Applicant has amended claims 1 and 9 to provide proper dependence for claims 5 and 12, respectively. Therefore, these rejections should be withdrawn.

Claims 6 and 13

The Examiner has rejected claims 6 and 13 under 35 U.S.C. § 112 as being indefinite for not clearly depending from independent claims 1 and 9, respectively. These rejections are moot as applicant has canceled claims 6 and 13.

III. 35 U.S.C. § 102

Claims 1, 2, 4, 9, 10 and 15-17 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,124,892 to Lambert. These rejections are moot as

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claims 1, 9 and 15 have been amended to further include the direction of the emitted light being normal to the human finger or thumb.

To anticipate a claim, the cited reference must disclose each and every limitation recited in the subject claim. "Anticipation requires the disclosure in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)). As set forth below, Lambert fails to disclose at least one element recited in each of the claims.

As described and claimed in the present application, a lighting device 100 includes a housing 110 and a light source 170 (paragraph 0015 – paragraph 0018). The light source 170 can be triggered by a power source such as a battery 230, which is also housed within the housing 110 (paragraph 0019). When power is transferred from the battery 230 causing the light source 170 to activate and produce light, the direction of that emitted light is normal to a person's finger or thumb (amended paragraph 0020). This is because the trigger button 160 rests atop the battery 230 and "provides a means for the user to intermittently activate the lighting device 100" (paragraph 0021). As illustrated in Figures 1 and 3, the trigger button 160 for activating the light source 170 within the housing 110 resides behind the light source 170 and maintains physical contact with the light source 170 through a flat spring 220 confined within a first collar 140 (paragraph 0021). Consequently, one of ordinary skill in the art will appreciate that when the lighting device 100 is worn on a person's finger or thumb and activated by pressure to the trigger button 160, the emitted light from the light source 170 will be normal to the trigger button 160 and therefore, normal to the person's finger or thumb. As such, applicant believes that the amendments to the claims are fully supported by the disclosure of the Application as filed, and as such, do not introduce new matter.

Accordingly, the present claims are patentably distinct as written, and the rejection of these claims under Section 102 must be withdrawn. Specifically, claim 1 has been amended to further include "wherein when activated, the direction of the emitted light is normal to the human finger or thumb." Likewise, claim 9 has been amended further

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include "wherein when activated, the direction of the emitted light is normal to the human finger or thumb." Similarly, claim 15 has been amended to further include "wherein the direction of the emitted light from the one or more light sources is normal to the fingers or thumbs."

Lambert, in contrast, discloses an illuminating device 20 comprising an elongated housing 22, a lamp comprised of a light emitting diode 24, and a self-contained energy source such as a battery 26 (col. 2, lines 26-29). When the illuminating device 20 is worn on a person's finger or thumb and activated by the activation switches 32, 34, the emitted light is longitudinal to the person's finger or thumb (Figs. 1 and 3). In other words, the emitted light of Lambert's illuminating device 20 is parallel to the direction that the finger or thumb is pointing towards (Figs. 1 and 3). This is because the objective of Lambert's illuminating device is to illuminate the gauges in a cockpit (col. 1, lines 42-43) and to produce an illuminating device with a sufficiently high intensity to enable a pilot to see items in the cockpit (col. 1, lines 45-46). Furthermore, the illuminating device must not adversely affect the airplane's night vision system or be seen from outside the cockpit (col. 1, lines 47-48). Accordingly, Lambert fails to disclose a lighting device 100 whereby the direction of the emitted light is normal to a finger or thumb because there is no teaching or motivation in Lambert, explicitly or inherently, to produce such a lighting device 100.

There is no teaching or motivation for Lambert to produce a lighting device 100 of the present application whereby the emitted light is normal to a finger or thumb because a pilot using the presently disclosed lighting device 100 would not illuminate the gauges in a cockpit, but would instead have the emitted light shined in their eyes. To do so would defeat the principle of operation of Lambert's illuminating device 20, which is to produce a device that shines light straight forward or parallel to the direction that a finger or thumb is pointing thereby lighting the instruments in the cockpit providing adequate means of operation. Likewise, the lighting device 100 of the present application would not produce an illuminating device with sufficient intensity to enable a pilot to see items in the cockpit because the emitted light are normal to a finger or thumb and would be dispersive and not concentrated with enough intensity. Last but not least, the disclosed lighting device 100 of the present application would defeat the intended purpose or render it unsatisfactory

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because the emitted light normal to a finger or thumb would adversely affect the airplane's night vision system and be readily seen from outside the cockpit by lighting up the cockpit in all directions and orientations. Therefore, Lambert includes no teaching or motivation, explicit or inherent, of producing emitted light being normal to the human finger or thumb.

Accordingly, since Lambert fails to expressly or inherently disclose each element in claims 1, 9 and 15, and specifically because Lambert does not expressly or inherently disclose an emitted light normal to a finger or thumb as recited in amended claims 1, 9 and 15, the Section 102 rejection of claims 1, 9 and 15 must fail. In addition, since claims 2, 4, 10, 16 and 17 depend from and further limit claims 1, 9 and 15, the rejection of these claims is also overcome. Therefore, claims 1, 2, 4, 9, 10 and 15-17 are patentably distinct as written, and the rejection of these claims under Section 102 should accordingly be withdrawn.

IV. 35 U.S.C. § 103

Claims 3, 5-8, 11-14 and 18 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Lambert in view of U.S. Patent No. 914,975 to Radley. Claims 6 and 13 have been canceled so the rejections to these claims are moot.

With regards to claims 3, 5, 7, 8, 11, 12, 14 and 18, Lambert does not disclose or teach all of the elements recited in independent claims 1, 9 and 15 as discussed above. See discussion *supra*. Therefore, Applicant respectfully asserts that these claims are not obvious in view of Lambert, since these dependent claims depend from and further limit independent claims 1, 9 and 15. The arguments made above with respect to independent claims 1, 9 and 15 regarding the applicability of the Lambert reference apply with equal force here. See discussion *supra*. For at least these reasons, Lambert does not teach or suggest all of the elements of independent claims 1, 9 and 15, from which the rejected dependent claims 3, 5, 7, 8, 11, 12, 14 and 18 depend. Thus, Applicant respectfully requests that the Examiner withdraw the Section 103 rejection.

Furthermore, the combination of Radley and Lambert would render the invention unsatisfactory for its intended purpose because there is no teaching or motivation, explicit or inherent, of producing emitted light being normal to the human finger or thumb. See

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discussion *supra*. Therefore, Applicant respectfully requests that the Examiner withdraw the Section 103 rejection because there is no incentive or motivation to combine Lambert and Radley, and furthermore because the combination would render the invention unsatisfactory for its intended purpose.

For these reasons, the Examiners burden of factually supporting a *prima facie* case of obviousness has not been met, and the rejection under Section 103 of claims 3, 5, 7, 8, 11, 12, 14 and 18 should be withdrawn.

V. New Claims

New claims 19-34 have been added to the application. These claims are rewritten independent and dependent forms of claims 1-5, 7-12 and 14-18. The Examiner initially rejected claims 1-5, 7-12, and 14-18 as being indefinite for having both "a resilient strap" and "two or more flexible members." Claims 1-5, 7-12 and 14-18 have retained "a resilient strap," while claims 19-34 are directed to "two or more flexible members." Since claims 1-5, 7-12 and 14-18 having "a resilient strap" patentably define over the cited references as discussed above, the independent and dependent forms of the otherwise allowable subject matter having "two or more flexible members" in claims 19-34 are also patentably definable over the cited references. See discussion *supra*. Therefore, these new claims 19-34 should also be allowed.

VI. Conclusion

Claims 1, 9 and 15 patentably define over the cited references and are now in condition for allowance. Since claims 2-5, 7, 8, 10-12, 14 and 16-18 depend from and further limit amended independent claims 1, 9 and 15, these claims are also in condition for allowance. Additionally, claims 19-34 are also in condition for allowance because they are rewritten independent and dependent forms of the alternate allowable subject matter of claims 1-5, 7-12 and 14-18, namely with "two or more flexible members."

It is respectfully submitted that the application is now in condition for allowance and, accordingly, reconsideration and allowance are respectfully requested. Should any questions remain regarding the allowability of the application, the Examiner is invited to

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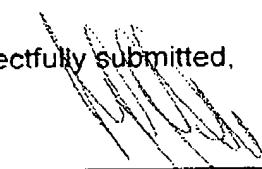
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The Commissioner is hereby authorized to charge any deficiency or credit any overpayment of fees which may be required by this paper to Deposit Account No. 502466 including any fee for extension of time, or the fee for additional claims which may be required. Please show our docket number with any Deposit Account transaction. A copy of this letter is enclosed

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